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09/877,729	06/08/2001	Franz Wakefield	4551.002	8957

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COOLTV NETWORK.COM, INC.
17731 Northwest 14th Court
Miami, FL 33169

EXAMINER

PESIN, BORIS M

ART UNIT PAPER NUMBER

2174

DATE MAILED: 06/06/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/877,729

Applicant(s)

WAKEFIELD, FRANZ

Examiner

Boris Pesin

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 March 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

This communication is responsive to an amendment filed 03/20/2006.

Claims 1-20 are pending in this application. Claims 1, 8, and 20 are independent claims. In the amendment filed 03/20/2006, Claims 1-9, 11-18, and 20 were amended. This action is made Final.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

For the record, the pro se Applicant and the Examiner have had numerous phone interviews where the Examiner has attempted to assist the pro se Applicant in constructing one allowable claim. On March 9, 2006, the Examiner emailed the pro se Applicant with a proposed claim that he felt would be allowable if the pro se Applicant were to propose it as an amendment in a reply to the Office action dated 12/28/2005.

The claim read:

1. (Amended) A multifunctional hot spot apparatus comprising:

A set of processed or readable instructions storable on a retaining medium;

At least one hot spot defined by any communication with said instructions;

At least one of the hot spots being accessible from a globally accessible network; Means for performing at least one of a plurality of predetermined functions executed with the selection of each particular hot spot;

Wherein said hotspots reside on and are accessible from a digital video or audio file;

Wherein said predetermined functions are selected from a mode control;

***Wherein the mode control comprises a plurality of modes;
Wherein the plurality of modes comprise of a shop mode, a bid mode, an interact mode, an entertainment mode, and a link mode;
Wherein a specific mode is selected through an expandable graphical user interface bar;
Wherein said specific mode further toggles based on time stamps in said digital video or digital audio file;
Wherein said multifunctional hot spots are delineated by outlines, shading, or illumination at a predetermined area on the display;
Means, defined by said instructions, for selecting and activating at least one of said predetermined functions by clicking one each particular hotspot.***

Claim Objections

Claim 2, 13, and 17 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim.

Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form.

Claim 2 does not further limit because claim 1 already has a means for identifying by outlining.

Claim 13 does not further limit because claim 1 already recites that the hot spots are accessible from a digital media file.

Claim 17 does not further limit because claim 1 already recites reaching a predetermined segment of a digital media file.

Claim 18 is objected to because of the following informalities:

On line 2 of the claim, the Applicant states "overwriting" however the specification discusses "overriding." Did the Applicant mean to say overwrite or override? The Examiner requests the Applicant to clarify, and if necessary, appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-20 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Independent claims 1 and 20 recite,

Wherein said multifunctional hotspot apparatus is made to reside on and is compatible with any computing system, and wireless or portable mobile handheld media device or player, including mobile phones, and mobile toy or digital player;

Wherein said mobile handheld media device/player or mobile toy, a specific mode is selected through a custom keypad (mode control bar) or user designated keys selected through a graphical user interface.

Independent claim 8 recites,

A storage, retrieval, and modification-area apparatus...

A set of processed or readable instructions ... for separating digital video and digital audio files in and from digital media and means defined to facilitate the separation of digital video and digital audio...

These limitations are not in the specification as originally filed.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claims 1, 8, and 20, the phrase "such as" renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention. See MPEP § 2173.05(d).

Regarding claims 11 and 12, the phrase "linked" renders the claim indefinite because it is unclear whether the limitation(s) following the phrase are part of the

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claimed invention. See MPEP § 2173.05(d). Why does the Applicant put the word "linked" in quotes, it makes the claim ambiguous.

Claim 8 recites the limitation "said hotspot" in Line 4. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim 20 is rejected under 35 U.S.C. 102(b) as being anticipated by Vanechanos, JR. (US 5884309).

In regards to independent claim 20, Vanechanos teaches a software apparatus for use on a globally accessible website, comprising:

An application software apparatus for use on a globally accessible website, or network, or for user on any wireless or portable mobile handheld media device or player, including mobile phones, any mobile toy or digital media player comprising: A set of processed readable instructions stored on a tangible medium for creating and controlling at least one pre-identified multifunctional hot spot, said multifunctional hot spot having a plurality of predetermined functions (i.e. *"The HTML code that search processor 62 generates in association with each item in the temporary item file may include a hyperlink. The search form may thus allow a user to view images of the items*

or obtain further information about an item or its manufacturer by clicking on hot-spots (not shown). The merchant parameter file may include statements that specify associated image files, HTML files, or URLs. If an associated object is an image file or HTML file, search processor 62 generates HTML code representing a hyperlink to it. If an associated object is a URL, search processor 62 generates HTML code representing a hyperlink having that URL." Column 15, Line 14); wherein said functions dictating the action taken by said multifunctional hot spots when activated, said functions having a means for accessing predetermined locations that are accessible from a globally accessible network (i.e. *"The HTML code that search processor 62 generates in association with each item in the temporary item file may include a hyperlink. The search form may thus allow a user to view images of the items or obtain further information about an item or its manufacturer by clicking on hot-spots (not shown). The merchant parameter file may include statements that specify associated image files, HTML files, or URLs. If an associated object is an image file or HTML file, search processor 62 generates HTML code representing a hyperlink to it. If an associated object is a URL, search processor 62 generates HTML code representing a hyperlink having that URL."* Column 15, Line 14); means for selecting and activating at least one function from said plurality of functions based on predetermined parameters, at least one of said predetermined parameters comprising a user originated input that selects and activates at least one function from said plurality of functions when said multifunctional hot spot is activated (i.e. *"The HTML code that search processor 62 generates in association with each item in the temporary item file may include a*

hyperlink. The search form may thus allow a user to view images of the items or obtain further information about an item or its manufacturer by clicking on hot-spots (not shown). The merchant parameter file may include statements that specify associated image files, HTML files, or URLs. If an associated object is an image file or HTML file, search processor 62 generates HTML code representing a hyperlink to it. If an associated object is a URL, search processor 62 generates HTML code representing a hyperlink having that URL." Column 15, Line 14, the user selects the link to activate the function of retrieving the data).

Claim 8 is rejected under 35 U.S.C. 102(b) as being anticipated by Rothmuller (US 6075526).

In regards to claim 8 Rothmuller teaches a storage, retrieval, and modification-area apparatus comprising: means for providing sessions for storing, modifying, accessing and activating digital media when said hot spot is activated, A set of processed or readable instructions storable on a retaining medium, providing a means for separating digital video and digital audio files in and from digital media and means defined to facilitate the separation of digital video and digital audio with at least one multifunctional hot spot (Column 3 Lines 34-43).

Response to Arguments

Applicant's arguments with respect to claims 1-20 have been considered but are moot in view of the new ground(s) of rejection.

Allowable Subject Matter

Claim 1-7, and 9-19 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, 1st and 2nd paragraph, set forth in this Office action.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Inquiry

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Boris Pesin whose telephone number is (571) 272-4070. The examiner can normally be reached on Monday-Friday except every other Friday.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kristine Kincaid can be reached on (571) 272-4063. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

BP

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